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EXAMINER

THANGAVELU, KANDASAMY

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,733

Applicant(s)

AALTONEN ET AL.

Examiner

Kandasamy Thangavelu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/15/2002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-35 of the application have been examined.

Foreign Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on an application 0031368-4 filed in Great Britain on December 21, 2000. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. Acknowledgment is made of the information disclosure statements filed on July 15, 2002 with a list of U.S and foreign patents. The patents have been considered.

Drawings

4. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.1 Claim 16 is rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Independent claim 16 recites a program as claimed in Claim 15, stored in a computer readable medium. The limitations recited in claim contain the steps for implementing the method in claim 6 in the computer program which are not statutory subject matter. To be statutory, the computer product should include a program comprising instructions which when executed in a computer performs a process comprising the steps included in the limitations.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

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7. Claims 1-3, 5-9, 11-15, 17-18, 21, 23-24, 27, 31-33 and 35 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Mott et al.** (U.S. Patent 6,170,060).

7.1 **Mott et al.** teaches a Method and apparatus for targeting a digital information playback device. Specifically, as per claim 1, **Mott et al.** teaches a software delivery apparatus (CL2, L60-65), comprising a controller connectable to a terminal and responsive to a request therefrom for software (CL8, L2-4; CL8, L59-60), and a terminal emulator (CL9, L42-45; CL9, L49-51) operable in accordance with a configuration of the terminal (CL8, L47-56) to validate the software prior to delivery to the terminal (CL11, L33-42).

Per claim 2: **Mott et al.** teaches the apparatus including storage for the terminal configuration (Fig. 1, Item 107; CL8, L47-56).

Per claim 3 and 24: **Mott et al.** teaches that the apparatus is connectable to the terminal via a wireless network (CL2, L60-65; CL3, L60-63).

Per claim 5: **Mott et al.** teaches that the terminal is mobile communications device (CL2, L60-65; CL5, L15-20).

7.2 As per claim 6, **Mott et al.** teaches a method of delivering software to a terminal (CL2, L60-65), comprising receiving a request for software from the terminal (CL8, L2-4; CL8, L59-60), sourcing the software (CL5, L46-54; CL5, L66 to CL6, L4), emulating the terminal (CL9,

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L42-45; CL9, L49-51) and validating the software against the emulation prior to delivering the software to the terminal (CL11, L33-42).

Per claim 7: **Mott et al.** teaches that the emulation is performed in accordance with a configuration derived from the terminal (CL8, L47-56).

Per claims 8 and 27: **Mott et al.** teaches that the emulation is performed in accordance with a configuration derived from an access network to which the terminal is connected (Fig. 2; CL8, L47-56).

Per claims 9 and 35: **Mott et al.** teaches that the access network is a wireless network (CL2, L60-65; CL3, L60-63).

Per claims 11 and 31-33: **Mott et al.** teaches selecting a software provider from whom the software is sourced in accordance with a database holding details of software sources (CL5, L46-54; CL8, L61-62).

7.3 As per claim 12, **Mott et al.** teaches a system for delivering software to a terminal (CL2, L60-65), comprises a controller having a connection to an access network (Fig. 2), through which a terminal issues a request for delivery of software (CL8, L2-4; CL8, L59-60), at least one software provider from whom the software is sourced by the controller (CL5, L46-54; CL5, L66 to CL6, L4), terminal emulation means (CL9, L42-45; CL9, L49-51) operable in accordance

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with a configuration of the terminal (CL8, L47-56) to validate the software prior to delivery to the terminal (CL11, L33-42).

Per claim 13: **Mott et al.** teaches a software provider database wherein the controller is operable to select from the database a suitable provider as a source to meet the request (CL5, L46-54; CL8, L61-62).

Per claim 14: **Mott et al.** teaches that the access network is a wireless network (CL2, L60-65; CL3, L60-63).

7.4 As per claim 15, **Mott et al.** teaches a computer program comprising executable code for execution when loaded on a computer wherein the computer is operable in accordance with the code to carry out the method according to Claim 6, the method for delivering software to a terminal (CL2, L60-65), comprising receiving a request for software from the terminal (CL8, L2-4; CL8, L59-60), sourcing the software (CL5, L46-54; CL5, L66 to CL6, L4), emulating the terminal (CL9, L42-45; CL9, L49-51) and validating the software against the emulation prior to delivering the software to the terminal (CL11, L33-42).

7.5 As per claim 17, **Mott et al.** teaches an application service provider (CL2, L60-65), comprising a controller operable to receive a request originating from a terminal the request identifying a software element for delivery to the terminal (CL8, L2-4; CL8, L59-60), sourcing the software (CL5, L46-54; CL5, L66 to CL6, L4), the controller being further operable to

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determine a configuration of the terminal (CL8, L47-56), and in response to the determination to source an appropriate software element to the terminal for delivery to the terminal (CL5, L46-54; CL8, L61-62).

Per claim 18: **Mott et al.** teaches that the controller is operable to generate a user a profile in response to a determination of a configuration of the terminal (CL8, L13-24; CL8, L47-53; CL11, L38-39).

Per claim 21: **Mott et al.** teaches that the controller is operable to source the software element only where the request is compatible with the user profile (CL8, L13-16).

Per claim 23: **Mott et al.** teaches that the controller is operable to access a database maintaining a list of provider addresses where software elements may be sourced (CL5, L46-54; CL8, L61-62).

Per claim 24: **Mott et al.** teaches that the apparatus is connectable to the terminal via a wireless network (CL2, L60-65; CL3, L60-63).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mott et al.** (U.S. Patent 6,170,060) in view of **Peterson et al.** (U.S. Patent Application 2001/0003828).

10.1 As per claims 4, 25 and 26, **Mott et al.** teaches the apparatus of claims 1, 2 and 3. **Mott et al.** does not expressly teach that the terminal is a set top box. **Peterson et al.** teaches that the terminal is a set top box (Page 8, Para 0117), because the set top box with internal computing unit permits receipt and rendering of web content on a web-enabled television set (Page 8, Para 0117). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the apparatus of **Mott et al.** with the apparatus of **Peterson et al.** that included the terminal being a set top box. The artisan would have been motivated because the

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set top box with internal computing unit would permit receipt and rendering of web content on a web-enabled television set.

11. Claims 10, 19, 28-30 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mott et al.** (U.S. Patent 6,170,060) in view of **Fulton et al.** (U.S. Patent 6,772,192).

11.1 As per claims 10 and 28-30, **Mott et al.** teaches the method of claim 6. **Mott et al.** teaches that the emulation is performed in accordance with a configuration derived from the terminal (CL8, L47-56). **Mott et al.** does not expressly teach that the emulation is performed in accordance with a configuration derived from a manufacturer of the terminal. **Fulton et al.** teaches the configuration derived from a manufacturer of the terminal (CL1, L49-50) and distributing software over a network from a server holding the software disk image to the terminal serving as a client upon a request from the client (CL1, L35-40), because the installed software should generally match the terminal hardware (CL1, L18-19). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the method of **Mott et al.** with the method of **Fulton et al.** that included the emulation being performed in accordance with a configuration derived from a manufacturer of the terminal. The artisan would have been motivated because the installed software should generally match the terminal hardware.

11.2 As per claim 19, **Mott et al.** teaches the provider of claim 18. **Mott et al.** teaches that the controller is operable to supplement the profile (CL8, L13-24; CL11, L38-39). **Mott et al.** does

not expressly teach that the controller is operable to supplement the profile using information provided by a manufacturer of the terminal. **Fulton et al.** teaches using information provided by a manufacturer of the terminal (CL1, L49-50) and distributing software over a network from a server holding the software disk image to the terminal serving as a client upon a request from the client (CL1, L35-40), because the installed software should generally match the terminal hardware (CL1, L18-19). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the provider of **Mott et al.** with the provider of **Fulton et al.** that included using information provided by a manufacturer of the terminal. The artisan would have been motivated because the installed software should generally match the terminal hardware.

Per claim 34: **Mott et al.** teaches selecting a software provider from whom the software is sourced in accordance with a database holding details of software sources (CL5, L46-54; CL8, L61-62).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mott et al.** (U.S. Patent 6,170,060) in view of **Metz et al.** (U.S. Patent 5,978,855).

12.1 As per claim 20, **Mott et al.** teaches the provider of claim 18. **Mott et al.** teaches that the controller is operable to supplement the profile (CL8, L13-24; CL11, L38-39). **Mott et al.** does not expressly teach that the controller is operable to supplement the profile using information provided by an operator of network of which the terminal is a member. **Metz et al.** teaches using

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information provided by an operator of network of which the terminal is a member (CL8, L61 to CL9, L3), because the server should adapt the coding scheme and other data transmission parameters to those utilized by the network (CL9, L1-3). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the provider of **Mott et al.** with the provider of **Metz et al.** that included using information provided by an operator of network of which the terminal is a member. The artisan would have been motivated because the server should adapt the coding scheme and other data transmission parameters to those utilized by the network.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Mott et al.** (U.S. Patent 6,170,060) in view of **Cochran et al.** (U.S. Patent 6,529,938); and further in view of **Fulton et al.** (U.S. Patent 6,772,192).

13.1 As per claim 22, **Mott et al.** teaches the provider of claim 17. **Mott et al.** teaches that the controller is operable to access a database holding details of software elements corresponding to the different requirements of various terminals (CL5, L46-54; CL8, L61-62). **Mott et al.** does not expressly teach that the controller is further operable to identify what software elements are required to achieve certain terminal configurations. **Cochran et al.** teaches that the controller is further operable to identify what software elements are required to achieve certain terminal configurations (CL1, L49-50), because as per **Fulton et al.** the installed software should generally match the terminal hardware (CL1, L18-19). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the provider of **Mott et al.**

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with the provider of **Cochran et al.** that included the controller being further operable to identify what software elements are required to achieve certain terminal configurations. The artisan would have been motivated because the installed software should generally match the terminal hardware.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kandasamy Thangavelu whose telephone number is 571-272-3717. The examiner can normally be reached on Monday through Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska, can be reached on 571-272-3716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

K. Thangavelu
Art Unit 2123
March 19, 2005



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